

15. (original) A silica reinforced rubber composition as specified in claim 1 wherein the rubbery polymer is a styrene-butadiene rubber.

REMARKS:

Claims 1, 3-7, and 15 have been rejected under 35 U.S.C. §103(a) as being obvious over the teachings of Mabry et al (United States Patent 6,075,084) in view of Jia et al (United States Patent 6,417,246). The Examiner has considered the response filed by the Applicants on October 13, 2003, but does not deem it to be persuasive. The claims pending in the subject patent application are now being amended to be further distinguish from the teachings of the prior art references. It is believed that this amendment overcomes the rejection made over the collective teachings of Mabry and Jia under 35 U.S.C. §103(a). In light of this amendment, the Examiner is accordingly respectfully requested to reconsider the rejection made under 35 U.S.C. §103(a).

As was acknowledged in the response filed on October 13, 2003, the Examiner is correct in that Mabry does disclose elastomer blends that contain fillers, including carbon black, fumed silica, precipitated silica, coated carbon black, and chemically functionalized carbon black.¹ However, Mabry does not disclose any necessity or even a preference for using elongated silica. In fact, silica is only one of a number of fillers that can be utilized in the compositions of Mabry. Accordingly, the teachings of Mabry do not render obvious the beneficial results that can be attained by utilizing elongated silica in the silica reinforced rubber compositions now being claimed.² In other words, the teachings of Mabry do not suggest or imply that superior reinforcement can be attained by utilizing elongated silica over other types of silica, such as spherical silica. This was the Applicants' unexpected discovery on which the invention now being claimed is based.

To supplement the teachings of Mabry, the Examiner cited Jia as a secondary reference. However, the teachings of Jia cannot be combined with those of Mabry in any

¹ See Mabry at column 14, lines 9-11. The Examiner has also noted that Mabry suggests that the filler will have an L/D ratio of less than 40 (see column 15, lines 47-50), but does not mention particle size.

² As can be seen from Table I on page 16 of the specification, a much higher level of reinforcement was attained with Snowtex SN-UPO elongated silica and Snowtex SN-UP elongated silica than was obtained with the spherical silicas.

manner that renders the silica reinforced rubber compositions now being claimed obvious. The teachings of Jia have the same shortcoming as do the teachings of Mabry. Namely, Jia does not suggest or imply that improved reinforcement characteristics can be attained in rubber compositions by utilizing elongated silica. In fact, Jia indicates that spherical silica particles are preferred (see column 3, lines 41-43). This is in contrast to the invention now being claimed where it has been shown that elongated silica provides a substantial benefit over spherical silica.

The teachings of Jia relate to resins used in dental compositions rather than rubbery polymers. Additionally, the dental compositions disclosed by Jia are comprised of a polymerizable resin composition. Accordingly, the teachings of Jia are not applicable to reinforced rubber compositions, such as those now being claimed. The claims pending in the subject patent application are now being amended to preclude the presence of polymerizable resin compositions which are essential in practicing the invention described by Jia. More specifically, claim 1 has been amended to include "consisting essentially of" as its transitional phrase which leaves it open only to the inclusion of unspecified additional ingredients that do not materially affect the basic and novel characteristics of the composition being claimed (see *In re Garnero*, 412 F.2d276, 162 USPQ221 (C.C.P.A. 1969)). The "consisting essentially of" transitional language now included in claim 1 accordingly precludes that compositions being claimed from containing a polymerizable resin which is critical to the compositions described by Jia.

The teachings of Jia also call for the silica used in the dental compositions described therein to be in the form of silica particles bound to each other so as to result in "chains having lengths in the range from about 50 nm to about 400 nm."³ Jia further states that without being bound by theory, that it is hypothesized that the "strings" of bound silica improve fracture resistance compared to discrete particulate materials.⁴ Thus, the teachings of Jia actually teach away from the utilization of discrete particles of elongated silica as called for in the claims of the subject patent application. The particle shape that Jia is describing is known as "string-of-pearls" rather than "elongated." To further illustrate this point, a web page from Nissan Chemical Industries's www.snowtex.com was submitted as Exhibit B to

³ See column 3, lines 46-48.

⁴ See column 3, lines 52-55.

the response filed on October 13, 2003. It shows that Snowtex silica can have a particle shape that is spherical, elongated or string-of-pearls.⁵

The teachings of Mabry cannot be combined with the teachings of Jia in a manner that renders the composition now being claimed obvious. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting that combination. ACS Hospital Systems, Inc. v. The Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the teachings of Jia cannot be combined with the teachings of Mabry in the present case since neither of these references suggests such a combination. Persons having ordinary skill in the art would have no logical basis for combining the teachings of Jia with the teachings of Mabry. There is no teaching in any of the cited prior art references that would motivate a person having ordinary skill in the art to combine certain select teachings of the references while ignoring others.

At the time the subject invention was made, persons having ordinary skill in the art would not have piecemealed together the teachings of the references being cited in the manner suggested by the Examiner. Obviousness is not determined by the application of hindsight, or retrospect, with the knowledge of the patentee's discovery. Rather, it is determined as of the time of the invention, based solely on the knowledge disclosed by the prior art as a whole. Republic Industries, Inc. v. Schlage Lock Co., 592 F.2d 963, 200 USPQ 769 (1979); Schnell v. Allbright-Nell Co., 348 F.2d 444, 146 USPQ 322 (1965). A prima facie case of obviousness has not been established. Thus, the claims pending in the subject patent application are not obvious in light of the teachings of the cited prior art references.

A Rule 131 Affidavit from Sun Lin Chen was submitted with the response filed on October 13, 2003 to show that the teachings of Jia could not properly be applied under 35 U.S.C. §102(e) in rejecting the claims pending in the subject patent application. However, the Examiner did not accept it on the basis that the Affidavit shows a reduction to practice of the invention prior to September 21, 2000⁶, but not prior to September 21, 1999. To "swear behind" Jia as a reference cited under 35 U.S.C. §102(e) it is only necessary to show a conception and reduction to practice of the invention being claimed before the actual filing

5 The silica used in the practice of the invention being claimed in the subject patent application has an elongated particle shape. This is in contrast to the string-of-pearls particle shape disclosed by Jia.

6 The Affidavit actually shows a reduction to practice before September 12, 2000.

date of Jia which is September 12, 2000. The Affidavit of Sun Lin Chen makes such a showing.

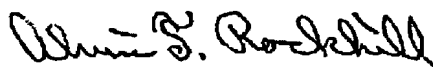
If the PTO wishes to rely upon the September 21, 1999 filing date of Provisional Patent Application Serial No. 60/155,292 in making a rejection under 35 U.S.C. §102(e) it must show that the provisional application contained support for the invention claimed in the referenced patent from the standpoint of §120 and §121. Only an application disclosing the patentable invention before the addition of new matter, which disclosure is carried over into the patent, can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a §102(e)/§103 rejection (see *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (C.C.P.A. 1981)). The PTO has not made such a showing with respect to the disclosure made in Provisional Patent Application Serial No. 60/155,292 and cannot rely upon its filing date. Thus, the Rule 131 Affidavit of Sun Lin Chen is effective to "swear-behind" the effective date of Jia. Thus, Jia cannot be used to support a rejection under 35 U.S.C. §102(e)/§103.

37 C.F.R. §1.131 indicates that when any claim of a patent application is rejected, the inventor of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. Since the PTO has not yet made any showing with respect to the disclosures made in Provisional Patent Application Serial No. 60/155,292, the effective date of Jia as a reference under 35 U.S.C. §102(e) is September 12 2000. The Rule 131 Affidavit of Sun Lin Chen shows that Jia is not prior art that can be used to support a rejection under 35 U.S.C. §102(e)/§103. The Rule 131 Affidavit shows that the inventors of the invention now being claimed had reduced their claimed invention to practice before the effective date of the Jia patent as a reference.

Accordingly, the Jia patent can not be deemed to be prior art under 35 U.S.C. §103.⁷ Accordingly, the rejection of the claims now pending in the subject patent which is dependent upon Jia should be withdrawn.

For the reasons delineated herein, the claims pending in the subject patent application are not obvious over the teachings of Mabry in view of Jia. In any case, the applicants have sworn behind to teachings of Jia by filing the Rule 131 Affidavit of Sun Lin Chen. It is now accordingly appropriate to allow the subject patent application and such an allowance is respectfully requested.

Respectfully submitted,



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⁷ Jia is not prior art that can be used to support a rejection under 35 U.S.C. §102(b) because Jia was not issued (patented or published) more than one year prior to the effective filing date of the subject patent application. The subject patent application has an effective filing date of December 29, 2000. The subject patent application claims the benefit of United States Provisional Application Serial No. 60,259,042, filed on December 29, 2000. The claims pending in the present patent application are fully supported by the earlier provisional filing. In fact, the claims filed in the provisional application are identical to the claims now pending in the subject patent application. Thus, Jia wasn't published more than one year before the effective filing date of the subject patent application. Thus, Jia cannot be used to support a rejection under 35 U.S.C. §102(b). Jia does not claim the subject matter being claimed in the subject patent application because the claims of Jia are directed to a polymerizable dental composition and a method of dental restoration. This is, of course, in contrast to the invention now being claimed which is directed to silica reinforced rubber compositions. Accordingly, 35 U.S.C. §102(g) is not applicable. 35 U.S.C. §102(c), 35 U.S.C. §102(d), and 35 U.S.C. §102(f) are clearly not applicable in the case at hand. Accordingly, none of the subsections of 35 U.S.C. §102 can be used to support a rejection of the subject invention based upon Jia since the Rule 131 Affidavit submitted herewith shows that a rejection under 35 U.S.C. §102(a)/103(a) and/or 35 U.S.C. §102(e)/103(a) is not appropriate.